

## **REMARKS**

This paper is filed in response to the Office Action dated March 2, 2005. As this paper is filed on May 31, 2005, the paper is timely filed.

### **I. Status of Amendments**

Claims 1-48 were originally filed. On December 9, 2004, the Office issued a restriction requirement setting out two groups, I (claims 1-30 and 36-43) and II (claims 31-35 and 44-48). Applicant elected Group I, with traverse, on December 29, 2004. In the March 2 Office Action, the Office maintained its restriction requirement.

Applicants hereby amend claims 1, 4, 5, 7, 8-10, 12, 13, 22, 27, 38, 37-39, and 42, cancel claims 3, 6, 23, and 41. Thus, claims 1, 2, 4, 5, 7-22, 24-40 and 42-48 inclusive are presently pending, with claims 31-35 and 44-48 withdrawn.

### **II. Response to the March 2 Office Action**

As an initial aside, applicant has amended the paragraph starting on page 11, line 11, to correct an obvious typographical error. The typographical error is clearly apparent when page 11, line 18, is compared with page 2, line 9, and with the Office's records. No new matter is added by this correction.

Claims 5, 7-12 and 36-38 are objected to as allegedly being in improper form. In response to the objection, claims 5, 7, 10, 12, and 38 have been amended to depend from a single claim. Claims 8, 9, 11, 36, and 37 already depend from a single claim.

Claims 1, 22, 39 and 43/39 are rejected under 35 U.S.C. §103 as allegedly unpatentable over Willis (U.S. Patent No. 5,803,143) in view of Brewer (U.S. Patent No. 4,205,799). Claims 2-4, 13-18, 23-30 and 40-43 are rejected under 35 U.S.C. §103 as allegedly unpatentable over Willis in view of Brewer further in view of Wada (U.S. Patent No. 5,680,999), claim 6 over Willis in view of Brewer further in view of Henreckson et al.

(U.S. Patent No. 6,079,645), claims 19 and 21 over Willis in view of Brewer and Wada further in view of Henreckson et al., claim 20/1 over Willis in view of Brewer further in view of Haeberle (U.S. Patent No. 3,960,335) and claim 20/13 over Willis in view of Brewer and Wada further in view of Haeberle. Applicant respectfully traverses the rejection of these claims and all the pending claims.

At the outset, it should be noted that, as discussed in greater detail in applicant's specification, the shredder apparatus of claim 1 includes a rotatable rotor that is disposed on a fixed shaft. In particular, the rotor is disposed on a bearing assembly, which is itself disposed on the fixed shaft, with the bearing assembly being substantially enclosed between the rotor and the shaft by first and second seal members. Second shredder members, which are adapted to cooperate with the first shredder members, are attached to the frame and also are mounted on, but free from rotation with, the rotor.

Willis fails to disclose, teach or suggest the subject matter of claim 1. Indeed, the Willis patent teaches away from applicant's invention.

Willis states that a hollow rotary drum 14 is mounted for rotation on a shaft 12 by bearings 16 located near drive belts 18. See Willis, col. 3:6-7 and Fig. 3. Willis further states that a plurality of individual wafer cutting units 28 are secured to the outer surface of the drum 14 and function to cut wood wafers. Willis, col. 3:13-18. The wafers fall by gravity through drum openings 78 into the hollow interior of drum 14 where the wafers impinge against the interior drum surface. Willis, col. 6:3-5. As wafers rotate almost one complete revolution, they engage a flexible doctor blade 104 at the outer end of collection chutes 106. See Willis, col. 6:6-8 and Figs. 3, 4, and 6. The chutes slope downwardly from drum reinforcing plate 110, axially to the outer ends of the drum 14. See Willis, col. 6:10-12.

Willis goes on to state that the opposite end portions of the drum are open circumferentially, as by means of arms 114 projecting axially outward of the solid portions of the drum. The open spaces 116 between the drum and end plates 22 provide outlets for the wafers to gravitate from the lower chute ends for deposit on to the underlying conveyors 30,30'. Willis, col. 6:17-24.

Willis does not disclose first and second shredder members that cooperate to shred wet chip materials as called for in applicant's claims. Willis discloses only one shredding unit

28 disposed on the outer surface of drum 14. As such, there is no disclosure, teaching or suggestion of having two cooperating shredder members, let alone having one of those shredder members fixed to the frame and mounted or seated on, but free from rotation with, the rotor.

Nor does Willis does disclose, teach or suggest the sealing of a bearing assembly within the allegedly corresponding rotor. To the contrary, Willis specifically teaches away from such a concept. The bearings 16 are disposed adjacent the open opposite ends of the drum 14, which leads to the bearings 16 being exposed to the materials exiting through the open spaces 116 to the conveyors 30, 30' below.

Brewer fails to overcome the deficiencies of the Willis patent.

Brewer states that a shredder apparatus is provided, the apparatus having stationary blade holders 42 mounted by bolts 43 on the front wall 28 of hopper 26. Brewer, col. 2:57-60 and Fig. 8. Brewer continues on to state that the holders, or plates, 42 extend upwardly from the bottom of the front wall 28 toward shaft 22 of the rotary cutter blade assembly 25. Brewer, col. 2:60-63.

An accurate surface 29 is provided at the upper end of the holder 42 that conforms to and is positioned "*in close proximity*" to shaft 22. Brewer, col. 2:65. Thus, contrary to the March 2 Office Action at page 5, line 6-7, the allegedly corresponding second shredder member does not have a first portion seated on a rotor but free from rotation with the rotor. The allegedly corresponding second shredder element is instead separate and spaced from, not seated on, the allegedly corresponding rotor. Brewer does not disclose, teach or otherwise suggest such an arrangement.

Further, absent the hindsight utilization of applicant's invention, there is no suggestion whatsoever for a person of ordinary skill in the art at the time the invention was made to combine structure disclosed in the Brewer patent with the apparatus disclosed in the Willis patent. It is not seen how the purported combination could physically be made absent using applicant's invention as a roadmap to arrive at applicant's shredder invention.

Similar to claim 1, claim 13, as amended, recites a shredder apparatus comprising a rotatable rotor disposed over a shaft and seated on a bearing assembly that is seated on the shaft. Claim 13 also recites a first seal member disposed on the shaft and located at the first

rotor end and a second seal member disposed on the shaft and located at the second rotor end, the seal members and rotor substantially enclosing the bearing assembly between the shaft and rotor. Further, claim 13 recites a plurality of spaced second shredder members attached to the frame and mounted on but free from rotation with the rotor, the second shredder members being adapted to cooperate with first shredder members. Consequently, applicants submit that the arguments made above relative to Willis and Brewer apply with equal force to claim 13, and that claim 13 is allowable.

Additionally, similar to claim 1, claim 22, as amended, recites a shredder apparatus comprising a rotatable rotor disposed on a bearing assembly that is disposed on a shaft. Claim 22 also recites a plurality of spaced second shredder members attached to a frame and mounted on but free from rotation with the rotor, the second shredder members being positioned relative to first shredder members whereby a first shredder member and a second shredder member are adapted to cooperate to shred wet chips. Moreover, claim 22 recites a seal assembly disposed between the rotor and the shaft for substantially enclosing and sealing the bearing assembly between the shaft and rotor. Consequently, applicants submit that the arguments made above relative to Willis and Brewer apply with equal force to claim 22, and that claim 22 is allowable.

Further, similar to claim 1, claim 39 recites a shredder apparatus comprising a rotatable rotor being disposed on a bearing assembly disposed on a shaft. Claim 39 also recites first and second seal members disposed on the shaft so that the bearing assembly is substantially enclosed and sealed within the rotor and shaft. Claim 39 additionally recites a plurality of spaced second shredder members attached to the frame and mounted on but free from rotation with the rotor. Consequently, applicants submit that the arguments made above relative to Willis and Brewer apply with equal force to claim 39, and that claim 39 is allowable.

It is respectfully submitted, that in light of the above remarks and amendment to claims 1, 13, 22, and 39, these claims are patentable and stand in condition for allowance. In light of the allowability of these claims, claims 2, 4, 5, 7-12, 14-21, 24-30, 36-38, 40, 42, and 43, which depend from these independent claims, also are allowable.

### **III. Information Disclosure Statement**

On September 30, 2003, applicant submitted a first Information Disclosure Statement in regard to the instant application. On February 6, 2004, applicant submitted a second Information Disclosure Statement in regard to this application. However, an initialed copy of only the Form PTO-1449 accompanying the February 6 Information Disclosure Statement was attached to the March 2 Office Action.

After reviewing the Office's PAIR database and the IFW for the instant application, it would appear that the September 30 Information Disclosure Statement was not included in the electronic records for this application. However, applicant has the return receipt postcard for the September 30 Information Disclosure Statement, bearing the Office's stamp of "OCT 06 2003." A copy of the return receipt postcard is attached. In accordance with MPEP 503, the postcard receipt itemizing the Information Disclosure Statement, the Form PTO-1449 and the "22 references" provided therewith serves as prima facie evidence of receipt in the USPTO of all items listed thereon on the date stamped by the USPTO.

As applicant submitted the September 30 Information Disclosure Statement in such a manner that the Office shall review the documents listed therein, applicant respectfully requests that the initialed copy of the Form PTO-1449 accompanying that Information Disclosure Statement be attached to the next Office Action, as evidence that the Office reviewed the documents listed thereon. To this end, applicant has included copies of the September 30 Information Disclosure Statement and accompanying Form PTO-1449 herewith. Applicant has not included the copies of the references listed on the Form PTO-1449 because, in the interim, the rules have been amended such that copies of U.S. patents and published applications are no longer required and every reference cited was either a U.S. patent or a U.S. published application.

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed

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herewith to our Deposit Account No. 13-2855, under Order No. 27330/38942. A duplicate copy of this paper is enclosed.

Dated: May 31, 2005

Respectfully submitted,

By 

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